

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants:

John R. Fredlund et al.

Serial No.: 09/960,678

Filed: 21 September 2001

SELECTING AN IMAGE BEARING
PRODUCT REQUIRING A
Title: PARTICULAR SIZE IMAGE
CONVERTED FROM A HIGH
RESOLUTION DIGITAL IMAGE

Group Art Unit: 2622

Examiner: Michael J. Carbonello

Attorney Docket No.: 83415RLO

MAIL STOP – APPEAL BRIEF PATENTS

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APPEAL BRIEF

Sir:

Further to the Notice of Appeal filed on 05 April 2006, appellants appeal the rejection of claims 1, 3-7, and 9, as finally rejected in the Final Office Action dated dated 20 October 2005. This Brief is timely, as it is filed within two months of the filing of the Notice of Appeal.

The fee for filing this Appeal is \$500. The Commissioner is authorized to charge \$500 (or any additional fees required to maintain the pendency of this application) to Deposit Account No. 05-0225.

Real Party in Interest - Rule 41.37(c)(1)(i)

The real party in interest is EASTMAN KODAK COMPANY.

Related Appeals and Interferences - Rule 41.37(c)(1)(ii)

No pending appeal, interference, or judicial proceeding that may be related to, directly affect or be directly affected by or have bearing on the Board's decision in this appeal is believed to exist. Appellants will identify any such appeal, interference, or judicial proceeding if it exists.

Status of Claims - Rule 41.37(c)(1)(iii)

Claims 1, 3-7, and 9 are pending in this application.

Claims 1, 3-7, and 9 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Fredlund et al. in view of Schroeder and Roberts et al.

No claims have been allowed.

Appellants appeal all pending claims 1, 3-7, and 9.

Status of Amendments - Rule 41.37(c)(1)(iv)

No claim was amended after the final rejection. A Notice of Appeal was filed on 5 April 2006. Appellants appeal claims 1, 3-7, and 9, as finally rejected. A copy of the claims involved in this appeal is appended hereto.

Summary of Claimed Subject Matter - Rule 41.37(c)(1)(v)

This application contains seven claims total, including one independent claim, claim 1, and six dependent claims, claims 3-7 and 9. All the claims are directed to a method of selecting an image bearing product that requires a particular resolution digital image. A user provides a high resolution digital image in memory at a first location, and a service provider provides information at the first location which contains at least two image bearing products. The user then selects one of the image bearing products to be provided by the service provider, and subsequently the service provider communicates the resolution required for the selected product to the first location. Next, in response to the communicated required resolution, the high resolution digital image is automatically converted to a low resolution image as necessary for the selected image bearing product. Afterwards, the lower resolution digital image is sent from the first location to the service provider, which uses the lower resolution digital image to produce the selected image bearing product. See paragraphs 5-10. Also see FIGS. 1 and 2.

The method further encompasses using a digital camera to capture the high resolution digital image. See paragraph 2.

The method further encompasses the case that at least two image products include prints of different sizes. See paragraphs 27, 29, and 36-40. Also see FIG. 3, block 150.

The method further encompasses the case where at least two image bearing products are photo albums. See paragraphs 27, 28, 37, and 39. Also see FIG. 1, blocks 56, 60, and 62, and FIG. 4.

The method further encompasses establishing a service account for the user with the service provider. See paragraphs 34 and 35. Also see FIG. 2, blocks 102 and 104, and FIGS. 5A, 5B, and 6.

The method further encompasses providing payment for the selected photo product. See paragraph 32 and 34. Also see FIG. 1, blocks 46 and 48, and FIG. 2, blocks 102 and 123.

Finally, the method further encompasses a converting step which further includes a modification of the number of bits per pixel in order to produce the lower resolution digital image. See paragraph 44. Also see FIG. 2, block 107.

Grounds of Rejection to be Reviewed on Appeal - Rule 41.37(c)(1)(vi)

1. Would it be obvious to modify the system of Fredlund et al. to automatically convert a digital image from high to low resolution based on a selected product as set forth in independent claim 1 in view of Schroeder and Roberts et al.

Appellants' Arguments - Rule 41.37(c)(1)(vii)

1. **ROBERTS ET AL. DISCLOSES A STILL VIDEO CAMERA WITH DIGITAL FORMAT OUTPUT, SCHROEDER DISCLOSES A METHOD FOR RAPID DIGITAL IMAGE RESIZING, AND FREDLUND ET AL. DISCLOSES A SYSTEM AND METHOD FOR REMOTELY SELECTING A PHOTOGRAPHIC IMAGE, BUT NEITHER ROBERTS ET AL. NOR SCHROEDER SUGGESTS THE MODIFICATION OF FREDLUND ET AL. TO CONVERT A DIGITAL IMAGE FROM HIGH TO LOW RESOLUTION BASED ON A SELECTED PRODUCT.**

In rejecting claim 1, the examiner contends that it would have been obvious to modify Fredlund et al. to incorporate the digital camera of Roberts et al. in order to generate digital image data. Appellants agree that it was well known to produce digital images using a digital camera. However, Roberts et al. does not disclose or suggest the conversion of digital image data from high to low resolution in a system such as disclosed in Fredlund et al. based on a selected product.

In order to overcome the deficiencies of the combination of Fredlund et al. with Roberts et al. in meeting the elements of the claims at issue, the examiner contends that it would have been obvious to further modify the system and method of Fredlund et al. to resize digital images according to the method described in Schroeder. While Schroeder does disclose a method for rapid digital image resizing, the reference fails to provide any motivation for incorporating such a digital image resizing operation into the system of Fredlund et al. Specifically, nothing in Schroeder, Roberts et al. or Fredlund et al. suggests or provides any motivation for the features found in elements (d) and (e) of claim 1. Accordingly, appellants submit that the combination, even if technically feasible, would not have been suggested by the teachings of the references themselves.

Indeed, as set forth in the seminal Supreme Court case, *Graham v. John Deere*, to establish a prima facie case of obviousness, the examiner must identify a teaching or suggestion of the desirability of doing what the inventors here have done. That is, to establish that the claimed invention is directed to an obvious subject matter, either the applied reference must expressly or implicitly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why an ordinary artisan would have found the claimed invention to have been obvious in light of the teachings of the applied references. The suggestion or the examiner's reasoning, however, must be objective and supported by evidence. See MPEP §§ 2142, 2143, 2143.01.

In rejecting claim 1, the examiner provides no evidence from any of the combined references which would teach or motivate such a combination or would otherwise suggest elements (d) and (e) of claim 1. The examiner proposes his own hypothetical motivations for such a combination, but only as a matter of hindsight and not as a matter of evidence from the cited references. It is a well established that the use of hindsight knowledge of an applicants own invention cannot provide the motivation for combining references.

The method steps of elements (d) and (e) describe the conversion of an image from a high to low resolution as the result of communication between a first location, where the digital image resides, and the service provider, where the image must eventually reside. A user selects a particular image bearing product, and as a result the service provider communicates the necessary resolution for the image according to the selected product. The image is automatically reduced in resolution and transferred to the service provider. It is important to note that this reduction of resolution is distinct from a compression process performed by a program like WINZIP, which is additionally cited by the examiner in his final rejection (page 3, paragraph 2). A compression process is ostensibly followed up by a decompression process

after transfer, which doesn't even occur in the examiner's proposed combination, much less the present invention. Method steps (d) and (e), which *changes the resolution of an image from high to low* prior to transfer, based on the needs of the image bearing product, is not a part of any conceivable permutation of the examiner's proposed combination. The examiner thus has failed to meet the burden of establishing a *prima facie* case of obviousness.

Conclusion

Appellants submit that claims 1, 3-7, and 9 patentably distinguish over the applied references and thus urge the Board to reverse the final rejection of the claims.

Respectfully submitted,

DATE
16/2/06


RAYMOND L. OWENS

REG. NO. 22,363

EASTMAN KODAK COMPANY
TELEPHONE: 585-477-4653
FACSIMILE: 585-477-4646

CLAIMS ON APPEAL (CLAIM APPENDIX) - Rule 41.37(c)(1)(viii)

1. (Previously Presented) A method of selecting an image bearing product that requires a particular resolution digital image, characterized by:
 - a) a user providing a high resolution digital image in a memory at a first location;
 - b) a service provider providing information which is displayed at the first location, such displayed information including at least two different image bearing products that can be provided by the service provider that require at least two different resolution digital images;
 - c) the user selecting one of the image bearing products to be provided by the service provider after viewing the displayed images;
 - d) the service provider communicating the resolution required for the selected image bearing product to the first location;
 - e) responsive to the communicated required resolution, automatically converting at the first location, the high resolution digital image to a lower resolution digital image corresponding to the selected image bearing product; and
 - f) sending the lower resolution digital image from the first location to the service provider;
 - g) utilizing the lower resolution digital image to produce the selected image bearing product.
2. Canceled.
3. (Original) The method of claim 1 further including using a digital camera to capture the high resolution digital image.
4. (Previously Presented) The method of claim 1 wherein the at least two image products include prints of different sizes.
5. (Previously Presented) The method of claim 1 wherein the at least two image bearing products are different photo albums.
6. (Previously Presented) The method of claim 1 further including the step of:
 - h) establishing a service account for the user with the service provider to permit the user to have access to ordered services.

7. (Previously Presented) The method of claim 6 further including the step of:
 - i) providing payment for the selected photo product.
8. Canceled.
9. (Previously Presented) The method of claim 1 wherein the converting step further includes modifying the number of bits per pixel to produce the lower resolution digital image.

EVIDENCE APPENDIX - Rule 41.37(c)(1)(ix)

None.

RELATED PROCEEDINGS APPENDIX - Rule 41.37(c)(1)(x)

None.